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WU, RUTAO				
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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
6

7
8 *Ex parte* MICHAEL J. ROJAS
9

10 Appeal 2008-1566
11 Application 09/808,436
12 Technology Center 3600
13

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15 Decided: September 12, 2008
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17
18 Before HUBERT C. LORIN, ANTON W. FETTING,
19 and DAVID B. WALKER, *Administrative Patent Judges*.
20 FETTING, *Administrative Patent Judge*.

21 DECISION ON APPEAL

22 STATEMENT OF CASE

23 Michael J. Rojas (Appellant) seeks review under 35 U.S.C. § 134 of a
24 final rejection of claims 1-7, the only claims pending in the application on
25 appeal.

26 We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b)
27 (2002).

1 We AFFIRM and DENOMINATE AS A NEW GROUND OF
2 REJECTION PURSUANT TO 37 C.F.R. § 41.50(b).

3
4 The Appellant invented a way of cost accounting for data usage over a
5 network and for web hosting applications for managing telecommunications
6 devices. (Specification 1:17-19).

7 An understanding of the invention can be derived from a reading of
8 exemplary claim 1, which is reproduced below.

- 9 1. A method for cost accounting of data usage over a
10 network by network users, the network having a plurality of
11 internal IP addresses and access to a plurality of external IP
12 addresses over the Internet, the method comprising the steps of:
13 (a) detecting data packets having a source and destination IP
14 address moving over the network;
15 (b) classifying the detected data packets based on the source
16 and destination address;
17 (c) assigning the classified data packets to a network user;
18 (d) costing the classified data packets based on a predetermined
19 costing scheme; and
20 (e) accumulating and storing the costed data packets based on
21 the assigned user.

22 This appeal arises from the Examiner's final Rejection, mailed April 19,
23 2006. The Appellant filed an Appeal Brief in support of the appeal on
24 December 28, 2006. An Examiner's Answer to the Appeal Brief was mailed
25 on May 3, 2007. A Reply Brief was filed on July 2, 2007.

PRIOR ART

The Examiner relies upon the following prior art:

Saari US 6,338,046 B1 Jan. 8, 2002

Schweitzer US 6,418,467 B1 Jul. 9, 2002

REJECTIONS

Claims 1-4 and 6 stand rejected under 35 U.S.C. § 102(e) as anticipated by Saari.

Claim 5 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Saari and Schweitzer.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as unpatentable over Saari.

ISSUES

The issues pertinent to this appeal are

- Whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claims 1-4 and 6 under 35 U.S.C. § 102(e) as anticipated by Saari.
- Whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claim 5 under 35 U.S.C. § 103(a) as unpatentable over Saari and Schweitzer.
- Whether the Appellant has sustained its burden of showing that the Examiner erred in rejecting claim 7 under 35 U.S.C. § 103(a) as unpatentable over Saari.

1 The pertinent issue turns on whether the packets in Saari are classified
2 based on the source and destination address.

3 FACTS PERTINENT TO THE ISSUES

4 The following enumerated Findings of Fact (FF) are believed to be
5 supported by a preponderance of the evidence.

6 *Facts Related to Claim Construction*

7 01. The disclosure contains no lexicographic definition of
8 “classify.”

9 02. The ordinary and customary meaning of “classify” is to arrange
10 or organize according to class or category.¹

11 *Facts Related to Appellant’s Disclosure*

12 03. The Specification describes classifying user pairs (Specification
13 4:28 – 5:8).

14 04. The Specification describes Data Accounting classification as
15 determining which of four equivalent source-to-destination
16 conditions exist for the point-to-point data packet transfers
17 (Specification 7:13-15 and 9:4-13).

18 05. The Specification describes filtering as being used for
19 disregarding unwanted information (Specification 7:5-6).

¹ *American Heritage Dictionary of the English Language* (4th ed. 2000).

Saari

06. Saari is directed to determining charges for usage of network resources. At the time a connection is established with a network node, a billing message or cell is transmitted to the node over the connection. The billing cell contains billing and connection information which is copied by the node and used to produce billing information. Information cells are transmitted over the same connection subsequent to the transmission of the billing cell (Saari 2:1-12).
07. Saari's nodes also transmit their respective charging information to a common network billing system which generates the total charge in a final bill that is forwarded to the user (Saari 2:27-30).
08. Saari describes a list of factors that might be used in charging formulae as including, but not limited to, service class type, quality of service, any individual or combination of ATM traffic parameters, connection time, and other traffic flow parameters (Saari 4:31-33).
09. Saari describes how information identifying each node that processes the information carried by a billing cell may be encoded in the billing cell as the billing cell travels through the various connections between the source and destination. As such, the billing cell may be used as a means of tracking the actual route of the data as it passes through the network from one location to another (Saari 6:40-47).

Schweitzer

10. Schweitzer is directed to a network accounting and billing system (Schweitzer 2:19-20).

11. Schweitzer describes filtering as meaning discarding any record that belongs to a group of unneeded data records (Schweitzer 7:13-14).

12. Schweitzer describes how real-time, policy-based filtering and aggregation can be done. The process then performs data merges to remove redundant data. The billing record information can be accessed from external applications. Filtering and/aggregation and/or data enhancements can be done at any stage in the system (Schweitzer 10:26-39).

Facts Related To The Level Of Skill In The Art

13. Neither the Examiner nor the Appellant has addressed the level of ordinary skill in the pertinent arts of systems analysis and programming, cost accounting, accounting for network usage, network analysis and programming, and network communications. We will therefore consider the cited prior art as representative of the level of ordinary skill in the art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (“[T]he absence of specific findings on the level of skill in the art does not give rise to reversible error ‘where the prior art itself reflects an appropriate level and a need for testimony is not shown’”) (quoting *Litton*

1 *Indus. Prods., Inc. v. Solid State Sys. Corp.*, 755 F.2d 158, 163
2 (Fed. Cir. 1985).

3 14. One of ordinary skill knew that all packets transmitted using the
4 internet protocol (IP) had the source and destination embedded in
5 packet header data for the purpose of aggregating the packets back
6 into the original message the packets were derived from.

7 *Facts Related To Secondary Considerations*

8 15. There is no evidence on record of secondary considerations of
9 non-obviousness for our consideration.

10 PRINCIPLES OF LAW

11 *Claim Construction*

12 During examination of a patent application, pending claims are
13 given their broadest reasonable construction consistent with the
14 specification. *In re Prater*, 415 F.2d 1393, 1404-05 (CCPA 1969); *In*
15 *re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

16 Limitations appearing in the specification but not recited in the claim are
17 not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364,
18 1369 (Fed. Cir. 2003) (claims must be interpreted “in view of the
19 specification” without importing limitations from the specification into the
20 claims unnecessarily).

21 Although a patent applicant is entitled to be his or her own lexicographer
22 of patent claim terms, in *ex parte* prosecution it must be within limits. *In re*
23 *Corr*, 347 F.2d 578, 580 (CCPA 1965). The applicant must do so by placing
24 such definitions in the Specification with sufficient clarity to provide a

1 person of ordinary skill in the art with clear and precise notice of the
2 meaning that is to be construed. *See also In re Paulsen*, 30 F.3d 1475, 1480
3 (Fed. Cir. 1994) (although an inventor is free to define the specific terms
4 used to describe the invention, this must be done with reasonable clarity,
5 deliberateness, and precision; where an inventor chooses to give terms
6 uncommon meanings, the inventor must set out any uncommon definition in
7 some manner within the patent disclosure so as to give one of ordinary skill
8 in the art notice of the change).

9 *Anticipation*

10 "A claim is anticipated only if each and every element as set forth in the
11 claim is found, either expressly or inherently described, in a single prior art
12 reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628,
13 631 (Fed. Cir. 1987). "When a claim covers several structures or
14 compositions, either generically or as alternatives, the claim is deemed
15 anticipated if any of the structures or compositions within the scope of the
16 claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351 (Fed.
17 Cir. 2001). "The identical invention must be shown in as complete detail as
18 is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d
19 1226, 1236 (Fed. Cir. 1989). The elements must be arranged as required by
20 the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology
21 is not required. *In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990).

22 *Obviousness*

23
24 A claimed invention is unpatentable if the differences between it and
25 the prior art are "such that the subject matter as a whole would have been
26 obvious at the time the invention was made to a person having ordinary skill

1 in the art.” 35 U.S.C. § 103(a) (2000); *KSR Int’l v. Teleflex Inc.*, 127 S.Ct.
2 1727 (2007); *Graham v. John Deere Co.*, 383 U.S. 1, 13-14 (1966).

3 In *Graham*, the Court held that that the obviousness analysis is
4 bottomed on several basic factual inquiries: “[(1)] the scope and content of
5 the prior art are to be determined; [(2)] differences between the prior art and
6 the claims at issue are to be ascertained; and [(3)] the level of ordinary skill
7 in the pertinent art resolved.” 383 U.S. at 17. *See also KSR Int’l v. Teleflex*
8 *Inc.*, 127 S.Ct. at 1734. “The combination of familiar elements according to
9 known methods is likely to be obvious when it does no more than yield
10 predictable results.” *KSR*, at 1739.

11 “When a work is available in one field of endeavor, design incentives
12 and other market forces can prompt variations of it, either in the same field
13 or a different one. If a person of ordinary skill can implement a predictable
14 variation, § 103 likely bars its patentability.” *Id.* at 1740.

15 “For the same reason, if a technique has been used to improve one
16 device, and a person of ordinary skill in the art would recognize that it would
17 improve similar devices in the same way, using the technique is obvious
18 unless its actual application is beyond his or her skill.” *Id.*

19 “Under the correct analysis, any need or problem known in the field
20 of endeavor at the time of invention and addressed by the patent can provide
21 a reason for combining the elements in the manner claimed.” *Id.* at 1742.

ANALYSIS

Claims 1-4 and 6 rejected under 35 U.S.C. § 102(e) as anticipated by Saari.

The Appellant argues that the dependent claims are patentable for the same reasons as independent claim 1 (Appeal Br. 8) and accordingly we treat these claims as a group.

Accordingly, we select claim 1 as representative of the group.
37 C.F.R. § 41.37(c)(1)(vii) (2007).

The Examiner found that Saari anticipated claim 1 (Answer 3-4). The Appellant contends that Saari fails to describe elements (b) classifying the detected data packets based on the source and destination address (Appeal Br. 4-7); and (c) assigning the classified data packets to a network user (Appeal Br. 7-8).

In particular, regarding limitation (b), the Appellant contends that Saari does not teach charging strategies, does not enable one of ordinary skill to manipulate billing cell information, classifying source and destination IP addresses and that the Appellant's invention charges a user based solely on the source and destination IP address (Appeal Br. 5).

We disagree with the Appellant. As to whether Saari describes charging strategies, we find that the argument is not commensurate with the scope of the claim. Claim 1 only requires a predetermined costing scheme (Claim 1(d)). Saari's billing cell contains billing and connection information which is copied by a node and used to produce billing information (FF 06). Such a scheme, by virtue of being so laid out, is predetermined and meets limitation (d) of claim 1.

1 As to enablement of billing cell manipulation, Saari itself is indicative of
2 the level of ordinary skill in the art. See *Okajima v. Bourdeau*, 261 F.3d
3 1350, 1355 (Fed. Cir. 2001) (FF 13). Thus, we find that the implementation
4 details, such as data packet parsing, not explicitly described by Saari were
5 within the knowledge of one of ordinary skill, and Saari was accordingly
6 enabled as to such implementation detail knowledge.

7 As to classifying source and destinations, we first must construe the term
8 “classify” which is not lexicographically defined in the Specification (FF
9 01). The Specification describes two species of the genus classify, viz. user
10 classification and data accounting classification, but does not define the
11 genus (FF 03 & 04). Claim 1 does not recite either of these species, but
12 claim 1 instead broadly claims the genus which contains these two species.
13 The usual and customary meaning of classify is to arrange or organize
14 according to class or category (FF 02).

15 Saari explicitly describes how information identifying each node that
16 processes the information carried by a billing cell may be encoded in the
17 billing cell as the billing cell travels through the various connections
18 between the source and destination (FF 09). This is an extension of what
19 one of ordinary skill knew occurred in every packet, i.e. that all packets
20 transmitted using the internet protocol (IP) had the source and destination
21 embedded in packet header data for the purpose of aggregating the packets
22 back into the original message the packets were derived from (FF 14).

23 Thus, the destination necessarily arranges or organizes packets according
24 to class or category defined by the combination of source and destination to
25 reconstruct the original message. Thus, element (b) simply recites what

1 every destination machine must do to reconstruct a message passed over the
2 Internet.

3 The final contention is that the Appellant's invention charges a user
4 based solely on the source and destination IP address. We find this
5 argument is not commensurate with the scope of the claim. Claim 1 requires
6 nothing more of the costing scheme than that it be predetermined. There is
7 no linkage in claim 1 between the classification based on source and
8 destination and the costing performed.

9 As to the Appellant's contention regarding element (c), we find that
10 Saari explicitly transmits charging information to a common network billing
11 system which generates the total charge in a final bill that is forwarded to
12 the user (FF 07). Since the charges for the transmission are assigned to the
13 user, it necessarily follows that the traffic billed to that user, including the
14 classified data packets within that traffic, are assigned to the same user to
15 achieve that billing. As with costing, claim 1 does not require that the
16 classification be the basis for the assignment. Claim 1 requires only that,
17 having been classified, packets are assigned to a user.

18 The Appellant has not sustained its burden of showing that the Examiner
19 erred in rejecting claims 1-4 and 6 under 35 U.S.C. § 102(e) as anticipated
20 by Saari. Our reasoning differs from that of the Examiner in having relied
21 on the knowledge of one of ordinary skill regarding how IP packets are
22 classified. Therefore we treat this rejection as a new ground pursuant to
23 37 C.F.R. § 41.50(b).

*Claim 5 rejected under 35 U.S.C. § 103(a) as unpatentable over Saari and
Schweitzer.*

The Appellant argues claim 5, requiring a filtering process to exclude certain predetermined data packets from the costing step. The Examiner found that this was described by Schweitzer (Answer 5-6). The Appellant argues that merging is not filtration because all of the records of the larger file remain after merging (Appeal Br. 9). We disagree. Schweitzer describes both merging and filtering as being used to discard unwanted data (FF 11 & 12). The Appellant's disclosure describes filtering as being used for disregarding unwanted information (FF 05). Thus, Saari's description of merging and filtration are each consistent with the meaning of filtering disclosed by the Appellant.

The Appellant has not sustained its burden of showing that the Examiner erred in rejecting claim 5 under 35 U.S.C. § 103(a) as unpatentable over Saari and Schweitzer. This claim depends from claim 1, in which our reasoning differs from that of the Examiner in having relied on the knowledge of one of ordinary skill regarding how IP packets are classified. Therefore we treat this rejection as a new ground pursuant to 37 C.F.R. § 41.50(b).

Claim 7 rejected under 35 U.S.C. § 103(a) as unpatentable over Saari.

The Appellant argues independent claim 7, requiring a programmable device that contains both a network controller and a processor that classifies and costs data packets. The Examiner found that this was known to one of ordinary skill as the mechanism encapsulating Saari's system (Answer 6). The Appellant argues that the Examiner has shown no reason to modify

1 Saari for this because there is no reason to include a network controller and
2 cost processor in a single device (Appeal Br. 12). The Appellant also argues
3 claim 7 is patentable for the same reasons as claim 1.

4 We disagree with the Appellant. Any computer is a programmable
5 device. The Appellant is arguing no more than that it would not be obvious
6 to provide two functions that produce predictable results in a common
7 computer. “The combination of familiar elements according to known
8 methods is likely to be obvious when it does no more than yield predictable
9 results.” *KSR*, 127 S. Ct. at 1739. A combination of a network controller
10 and a cost processor produces the expected results of each of the
11 components in a single device. We find the arguments applied in support of
12 claim 1 to be equally unpersuasive toward claim 7 for the same reasons we
13 found *supra*.

14 The Appellant has not sustained its burden of showing that the Examiner
15 erred in rejecting claim 7 under 35 U.S.C. § 103(a) as unpatentable over
16 Saari. The Appellant’s arguments for this claim include arguments made for
17 claim 1. To that extent, our reasoning differs from that of the Examiner in
18 having relied on the knowledge of one of ordinary skill regarding how IP
19 packets are classified. Therefore we treat this rejection as a new ground
20 pursuant to 37 C.F.R. § 41.50(b).

CONCLUSIONS OF LAW

The Appellant has not sustained its burden of showing that the Examiner erred in rejecting claims 1-4 and 6 under 35 U.S.C. § 102 as anticipated by Saari, and claims 5 and 7 under 35 U.S.C. § 103(a) as unpatentable over the prior art.

The rejections of claims 1-7 are denominated as new grounds of rejection pursuant to 37 C.F.R. § 41.50(b).

DECISION

To summarize, our decision is as follows:

- The rejection of claims 1-4 and 6 under 35 U.S.C. § 102(e) as anticipated by Saari is sustained.
- The rejection of claim 5 under 35 U.S.C. § 103(a) as unpatentable over Saari and Schweitzer is sustained.
- The rejection of claim 7 under 35 U.S.C. § 103(a) as unpatentable over Saari is sustained.
- The rejections of claims 1-7 are denominated as new grounds of rejection pursuant to 37 C.F.R. § 41.50(b).

Our decision is not a final agency action.

In addition to affirming the examiner's rejection(s) of one or more claims, this decision contains new grounds of rejection pursuant to 37 CFR

1 § 41.50(b). 37 CFR § 41.50(b) provides “[a] new ground of rejection
2 pursuant to this paragraph shall not be considered final for judicial review.”

3 37 C.F.R. § 41.50(b) also provides that Appellants, WITHIN TWO
4 MONTHS FROM THE DATE OF THE DECISION, must exercise one of
5 the following two options with respect to the new rejection:

6 (1) Reopen prosecution. Submit an appropriate amendment of
7 the claims so rejected or new evidence relating to the claims
8 so rejected, or both, and have the matter reconsidered by the
9 Examiner, in which event the proceeding will be remanded
10 to the Examiner. . . .

11 (2) Request rehearing. Request that the proceeding be reheard
12 under § 41.52 by the Board upon the same record. . . .

13 Should the Appellants elect to prosecute further before the examiner
14 pursuant to 37 CFR § 41.50(b)(1), in order to preserve the right to seek
15 review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection,
16 the effective date of the affirmance is deferred until conclusion of the
17 prosecution before the examiner unless, as a mere incident to the limited
18 prosecution, the affirmed rejection is overcome.

19 If the appellant elects prosecution before the examiner and this does
20 not result in allowance of the application, abandonment or a second appeal,
21 this case should be returned to the Board of Patent Appeals and Interferences
22 for final action on the affirmed rejection, including any timely request for
23 rehearing thereof.

24

1 No time period for taking any subsequent action in connection with this
2 appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

3

4

AFFIRMED

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41.50(b)

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8 vsh

9

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